

## **REMARKS**

The Applicant respectfully requests reconsideration and Allowance of Claims 1-3, 5, 7-13, 15-17 and 19-20 in view of the following arguments.

### **35 U.S.C. §102 REJECTIONS**

Claim 17 was rejected under 35 U.S.C. 102(a) as being anticipated by International Publication No. WO 00/48098 to Carden ("Carden").

### **35 U.S.C. §103 REJECTIONS**

Claims 1-3, 5, 7-13, 15, 16, 19 and 20 were rejected under 35 U.S.C. §103(a) as obvious over Carden in view of U.S. Publication No. US 2002/0035697 to McCurdy et al. ("McCurdy").

## **STATUS OF THE CLAIMS**

Claims 1-3, 5, 7-13, 15-17 and 19-20 remain pending in this case.

Independent Claims 1, 12 and 17 have previously been amended to add the limitation of the creation of a galley by the remote service provider and the return of the galley to the author for the creation of the commercial grade publication from the galley. Further, the commercial grade publication is distributed as is, without modification. These amendments represented clarifications and did add further limitations to the respective claims.

### **CLAIM 17 IS NOT ANTICIPATED BY THE CITED ART.**

The Examiner rejected Claim 17 under 35 U.S.C. § 102 as anticipated by Carden, International Publication No. WO 00/48098. Applicant respectfully traverses this rejection on the ground that Carden does not disclose the creation of a galley by a remote service provider and the subsequent creation of a commercial grade publication from the galley and the distribution of the commercial grade publication without modification thereafter.

**CLAIMS 1-3,5, 7-13,15, 16 and 19-20 ARE NOT OBVIOUS IN VIEW OF THE CITED ART**

Further, the Examiner rejected Claims 1-3, 5-13, 15, 16, 19 and 20 under 35 U.S.C. § 103, as obvious over International Publication No. WO 00/48098 to Carden in view of U.S. Publication No. US 2002/0035697 to McCurdy et al.. Applicant respectfully traverses these rejections on the ground that Carden in combination with McCurdy does not suggest Applicant's invention as claimed and, further, there is no suggestion in McCurdy to modify the Carden device in the manner claimed.

**THE CARDEN PUBLICATION**

The Carden system does disclose a system that enables authors to submit materials to a publisher, society or agency, for review, editing and publishing. (Page 1, line 12-13). As those terms are used in Carden, however, it is clear that the author has submitted a commercial grade publication to begin with. That is, the written materials are transmitted from the author in one format and automatically translated into a common format for ease of review. This reformatted version is available for review by the author to ensure it translated correctly or the symbols used are correct. (Page 6, lines 26-29 and Page 14, lines 7-23, for example). After review of the translation or reformatted version, the author can approve it as a proper reformatted version. (Page 7, lines 20-22). But the author is transmitting "the completed material" not the first stage "authored work" as that term is used in Applicant's disclosure. This is clear from the Carden disclosure throughout and by inference since one of the questions Carden asks its authors is whether the abstract has been published elsewhere and whether it is part of a larger project. (Page 17, lines 27-29).

Further, Carden does provide for a review of the submitted material but it is significantly different than the required review in Applicant's system. In Carden, the reviewer may "comment" on the submitted material. (Page 8, lines 4-7). Further, the reviewer conducts the review by creating a score and/or comments on the Abstract of the material submitted. (Page 13, lines 1-4 and Page 21, lines 24-30, for example) No galley is created from the submitted work as that term is used by Applicant. Only a score or comments are created and the author is required to incorporate them in whatever manner he can.

All that Claim 1 of Carden discloses is, in pertinent part, a means for submitting a new document to a database; a means for reviewing the new document and a means for publishing a portion of the new document, ie the abstract. Claim 4 adds the limitation of translating the document from one format to a second format. All that can fairly be said

given the constraints of Carden as published is that it provides comments to an author on a finished work that he submits which, if accepted, is published as submitted. If it is not accepted, it is up to the author to figure out what changes to make. No disclosure or suggestion is made of the creation of a galley from the authored work. Nor is there any disclosure or suggestion of returning the galley to the author for the creation of a commercial grade publication. As a result, Applicant respectfully requests that the rejection of claim 17 as anticipated by Carden be reconsidered, withdrawn and the claim allowed.

#### **THE MCCURDY ET AL. PUBLICATION**

The McCurdy publication claims the benefit of a provisional application for an electronic magazine system for providing a user with "the ability to view pages of a document, such as a magazine, in a format that looks the same as a conventional printed version of the document and which permit the user to interface with portions of those pages in ways that may not be possible with the conventional printed version of the document." [0001-0002]. McCurdy discloses a technique for enabling a user to turn pages realistically, tear-out pages, mark pages and pass pages along to others. [0014] Further, McCurdy enables users to interact with advertisers and access embedded links, audio and video files. [0014]. Throughout, the only document being accessed in this so-called realistic system, is the final version of a publication, what Applicant has identified as the "commercial grade publication". (See eg page 1, lines 10-31 and page 2, lines 1-22.)

#### **Claim 1**

In contrast to the technique of McCurdy, which is essentially a system for the manipulation of an electronic copy of an already created commercial grade publication in a manner similar to manipulation of an actual document, while providing additional access electronically to advertisers and such, Applicant's independent Claim 1 (as well as independent Claims 12 and 17) is directed to the creation, via a communications network, of a commercial grade publication from an authored work. As used in the application, the term "commercial grade" publication means "an authored work prepared for commercial publication, such as a book, magazine, newspaper or pamphlet, for example." (See page 1, lines 14-17) These claims further require that editing of the authored work results in the creation of a galley. The galley is a comprehensive final draft of the authored work before

publication.(Page 1, line 31 and page 2, line 1) Then, on successful review of the galley, by the author, the resulting commercial-grade publication is advanced for publication. (Page 2, lines 4-5).

No such system is disclosed or suggested whatsoever by Carden and McCurdy either alone or in combination. McCurdy starts where Applicant's invention leaves off. That is, again, McCurdy discloses a system for electronic manipulation of a previously created commercial grade publication. Carden discloses a review that either approves the submitted material as is or results in "comments" not a comprehensive final draft of the authored work before the creation of a commercial grade publication. Applicant discloses and claims an apparatus and method for the remote electronic creation of a commercial grade publication from an authored work as both of those terms are defined. Further, Applicant's invention requires that the commercial grade publication is created from a galley created by a remote service provider and published by a sales manager without modification.

Comparing this with the system disclosed in , it is apparent that Carden does not teach or suggest such a remote service provider for editing an authored work for content as required in Claim 1. The Examiner concedes this but states that McCurdy provides this missing element and that it would have been obvious to modify the device disclosed by Carden to include the sales manager linked with the reposer for retrieving the commercial grade publication from the repository and distributing that commercial grade publication with out modification. Applicant respectfully disagrees. Carden does not teach or disclose Applicant's device for creating a commercial grade publication as discussed above. The Examiner concedes as much for all the remaining claims. McCurdy can fairly be said to teach only the manipulation of a commercial grade publication after it is created. Further, McCurdy does not teach or suggest the use of a remote service provider for editing the authored work for content in the creation of a commercial grade publication for the reason that it is not dealing with authored works.

In order to combine prior art references or modify a prior art reference under 37 U.S.C. 103, there must be some teaching or suggestion in the prior art to make the combination or modification. In this case, the Examiner does not point to any teaching or suggestion in the prior art to add the sales manager linked with the reposer for retrieving the commercial grade publication from the repository and distributing that commercial grade publication with out modification as required by Applicant's claims, but merely asserts that it would have been obvious for one of ordinary skill to do so "because it provides an effective means for selling electronic publications" (Page 4). This may be so, but Carden does not disclose or suggest a system for converting an authored work to a commercial grade

publication by submitting the authored work to a remote service provider who creates a galley and sends the galley to the author who converts the galley to the commercial grade publication. McCurdy, simply put, is a system to allow a person to read an electronic copy of a previously created commercial grade publication as if it were a real book, for example. No editing is required, suggested or legally permitted in most instances.

Most importantly, adding the sales manager to Carden as the Examiner suggests would necessarily change the principle of operation of the Carden technique. That is, Carden is an already functioning technique for manipulating an commercial grade work and providing comments, at best, on the commercial grade work or publishing it as is. No galley is created, required or suggested. Further, a sales manager is completely superfluous to the Carden device.

If the proposed modification of the prior art would change the principle of operation of the prior art device; then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F. 2<sup>nd</sup> 810, 123 U.S.P.Q. 349 (CCPA 1959) (see MPEP § 2143.01 at page 2100-99, second column). In the present case, it is clear that if any such sales manager is to be functional then the principle by which Carden operates must be changed. Thus, in accordance with *In re Ratti*, it could not have been obvious to make the Examiner's proposed modifications.

The Applicant therefore respectfully submits that Claim 1, as well as independent Claims 12 and 17 which require limitations similar to those in Claim 1, are not anticipated by, nor obvious over, Carden either alone or in combination with McCurdy and are entitled to allowance along with dependent claims 2-3,5, 7-11; 13, 15-16; and 19-20 respectively.

In sum, Applicant's independent claims 1, 12 and 17 each require the creation of a galley from the content editing. Further, the galley is sent to the author for creation of the commercial grade publication. Still further, the commercial grade publication is distributed without modification. Neither Carden nor McCurdy, in combination or alone, teach or suggest Applicant's invention as set forth in these independent claims.

### CONCLUSION

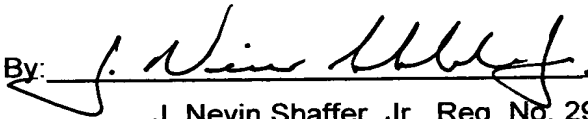
In light of the above, Applicant respectfully requests reconsideration and allowance of Claims 1-3, 5, 7-13, 15-17 and 19-20. If the Examiner should feel that any issue remains as to the allowability of these claims, or that a conference might expedite allowance of the claims, the Examiner is asked to telephone the undersigned attorney.

Applicant intends this to be a complete response. No fee is believed due; however if a fee is due, please charge deposit account number indicated on the transmittal letter.

Respectfully submitted,

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